

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Schofield et al.	Confirmation No.:	5687
Serial No.:	10/594,295	Art Unit:	1657
371(c) Date:	January 8, 2007	Examiner:	Paul C. Martin
Patent No.:	7,638,295 B2	Customer No.:	21559
Issued:	December 29, 2009		
Title:	ASSAYS FOR IDENTIFYING MODULATORS OF THE HYDROXYLATION OF ANKYRIN REPEAT PROTEINS BY 2- OXOGLUTARATE DEPENDENT OXYGENASE AND METHODS OF USING THE SAME		

APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705

In response to the Determination of Patent Term Adjustment under 35 U.S.C. § 154(b) set forth in the Issue Notification mailed in connection with the above-captioned patent application on December 9, 2009, and as set forth on the cover of U.S. Patent No. 7,638,295 B2 (“the ‘295 patent”), issued December 29, 2009, Applicants hereby request reconsideration of the patent term adjustment. Applicants submit that the current patent term adjustment should be 321 days, not 228 days as shown in the Patent Term Adjustment History on the PAIR system (Exhibit A).

Applicants refer to Office delay under 35 U.S.C. § 154(b)(1)(A), and the corresponding rules, as “A delay.” Applicants do not dispute the Office’s calculation that the ‘295 patent is entitled to 228 days of patent term adjustment for A delay incurred during prosecution (256 days of Office delay reduced by 28 days of Applicant delay) as shown in Exhibit A.

35 U.S.C. § 154(b)(1)(B) states:

Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States, not including-

(i) any time consumed by continued examination of the application requested by the applicant under section 132(b);

\* \* \*

the term of the patent shall be extended 1 day for each day after the end of that 3-year period until the patent is issued.

Corresponding provisions are found in 37 C.F.R. §§ 1.702(b) and 1.703(b). 37 C.F.R.

§ 1.703(b) states (emphasis added):

The period of adjustment under § 1.702(b) is the number of days, if any, in the period beginning on the day after the date that is three years after the date that is three years after the date on which ... **the national stage was commenced under 35 U.S.C. 371(b) or (f) in an international application and ending on the date a patent was issued.**

Applicants refer to Office delay under 35 U.S.C. § 154(b)(1)(B), and the corresponding rules, as “B delay.”

The ‘295 patent issued on the U.S. national stage application of PCT/GB2005/001150, which claims March 26, 2004 as its earliest priority date. The U.S. national stage of PCT/GB2005/001150 was “commenced” under 35 U.S.C. § 371(b) on September 26, 2006, upon expiration of 30 months from the priority date of PCT/GB2005/001150.<sup>1</sup> The period beginning on September 27, 2009 (the day after the

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<sup>1</sup> The request for national stage entry was filed on September 26, 2006 and included an express request to begin national examination procedures under 35 U.S.C. § 371(f), but all § 371(c) requirements were not met until January 8, 2007. Accordingly, the national stage commenced under 35 U.S.C. § 371(b) on September 26, 2006.

date that is three years after September 26, 2006, the date that the national stage commenced), and ending December 29, 2009 (the date the patent was issued), is 93 days in length. Applicants submit that the B delay for the '295 patent is 93 days.

In view of *Wyeth v. Kappos*, No. 2009-1120 (Fed. Cir., Jan. 7, 2010), Applicants submit that the periods of A delay and B delay described above do not overlap, and Applicants are entitled to both periods of delay. Here, 93 days of B delay should be added to the 228 days of A delay calculated by the Office for a total of 321 days of patent term adjustment. Applicants request that the patent term adjustment determination be corrected accordingly.

The '295 patent is not subject to a Terminal Disclaimer.

### CONCLUSION

Applicants submit that the current patent term adjustment should be 321 days and hereby request reconsideration of the patent term adjustment.

Transmitted herewith is \$200.00 in payment of the fee set forth in 37 C.F.R. § 1.18(e). If there are any additional charges or any credits, please apply them to Deposit Account No. 03-2095.

Respectfully submitted,

Date: February 25, 2010

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## EXHIBIT A

10/594,295	ASSAYS FOR IDENTIFYING MODULATORS OF THE HYDROXYLATION OF ANKYRIN REPEAT POTEINS BY 2-OXOGLUTARATE DEPENDENT OXYGENASE AND METHODS OF USING THE SAME	02-19-2010::14:01:34
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**Patent Term Adjustments**

Patent Term Adjustment (PTA) for Application Number: 10/594,295			
Filing or 371(c) Date:	01-08-2007	USPTO Delay (PTO) Delay (days):	-
Issue Date of Patent:	12-29-2009	Three Years:	-
Pre-Issue Petitions (days):	-	Applicant Delay (APPL) Delay (days):	-
Post-Issue Petitions (days):	-	Total PTA (days):	228
USPTO Adjustment(days):	-	Explanation Of Calculations	

**Patent Term Adjustment History**

Date	Contents Description	PTO(Days)	APPL(Days)
12-09-2009	PTA 36 Months		
12-29-2009	Patent Issue Date Used in PTA Calculation		
11-12-2009	Dispatch to FDC		
11-12-2009	Application Is Considered Ready for Issue		
11-10-2009	Issue Fee Payment Verified		
11-10-2009	Issue Fee Payment Received		
08-24-2009	Sequence Forwarded to Pubs on Tape		
08-11-2009	Mail Notice of Allowance		
08-07-2009	Document Verification		
08-07-2009	Notice of Allowance Data Verification Completed		
08-06-2009	Examiner's Amendment Communication		
06-02-2009	Information Disclosure Statement considered		
06-02-2009	Reference capture on IDS		
06-02-2009	Information Disclosure Statement (IDS) Filed		
07-03-2009	Date Forwarded to Examiner		
06-02-2009	Response after Non-Final Action		28
06-02-2009	Request for Extension of Time - Granted		⬆
06-02-2009	Information Disclosure Statement (IDS) Filed		⬆
02-05-2009	Electronic Review		⬆
02-05-2009	Email Notification		⬆
02-05-2009	Mail Non-Final Rejection		⬆
02-02-2009	Non-Final Rejection		
03-21-2007	Information Disclosure Statement considered		
12-29-2008	Date Forwarded to Examiner		
12-19-2008	Response to Election / Restriction Filed		
11-19-2008	Electronic Review		
11-19-2008	Email Notification		
11-19-2008	Mail Restriction Requirement	256	
11-17-2008	Requirement for Restriction / Election	⬆	
09-19-2008	Email Notification	⬆	

09-18-2008	PG-Pub Issue Notification	↑
09-04-2008	Case Docketed to Examiner in GAU	↑
07-28-2008	IFW TSS Processing by Tech Center Complete	↑
03-21-2007	Preliminary Amendment	↑
03-21-2007	Information Disclosure Statement (IDS) Filed	↑
06-24-2008	Application Dispatched from OIPE	↑
06-13-2008	Email Notification	↑
01-08-2007	371 Completion Date	↑
06-12-2008	Sent to Classification Contractor	
06-13-2008	Notice of DO/EO Acceptance Mailed	
06-13-2008	Filing Receipt	

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